

U.S. Application No.: 09/830,732
AMENDMENT B

Attorney Docket: 2368.119

REMARKS

Review and reconsideration of the Office Action of March 28, 2003, is respectfully requested in view of the above amendment and the following remarks.

Applicant would like to thank the Examiner for the indication that Claims 13-14 contain allowable subject matter. Claim 13 has been re-written in independent form.

No new matter has been added to the claims.

Applicant believes that Claims 10-12 and 15-18 are novel for the following reasons:

Applicant reviewed the West reference and notes that compared with Claim 10, the reference fails to teach **locking boreholes for locking and for receiving locking bolts associated with the case.**

In addition, Applicant notes that the GB'99 reference discloses a security box comprising a housing, a drawer having a lock in combination with locking pins 17. The locking pins are part of the independent lock system and not associated with the case.

Further, Applicant notes that the combination of the lock and locking pin of the GB'99 reference is equal to the security locking system 28 of the present invention. Thus, the GB'99 reference also fails to teach the locking boreholes for locking and for receiving locking bolts associated with the case in addition to the independent locking system.

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Combining the references

The Examiner is of the opinion that it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the locking boreholes of the housing of GB'99 and the locking bolts of the case of GB'99 in the housing and in the case of West, to secure the case in the housing.

Applicant does not agree with the Examiner's opinion. Applicant notes that the West reference requires the container to be closely fitted within jacket 11. The case is attached to the jacket only by close fit (Column 2, lines 5-16 and 37-39).

Lines 37-39 indicted:

"In order to permit safe or container 14 to be closely fitted within jacket 11, lock 28 must not protrude."

Thus, if the inventor of the West reference admits that the lock CANNOT protrude from the case, how can the Examiner believe that there is a possibility of modifying the West reference by adding the borehole for locking and for receiving locking bolts (protruding from case) associated with the case of the GB reference?

A §103 rejection based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, is not proper and the *prima facie* case of obviousness cannot be properly made. In short, there would be no technological motivation for engaging in the

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modification or change. To the contrary, there would be a disincentive. In re Gordon 221 USPQ 1125 (Fed. Cir 1984).

Adding the boreholes of the GB reference to the West reference will prevent the container to be closely fit with the jacket, thus the function of the invention will be destroyed.

Thus, a person skilled in the art will not find any technological motivation to combine the references.

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Office Action

Turning now to the Office Action in greater detail, the paragraphing of the Examiner is adopted.

Paragraphs 1 - 7 (Obviousness)

The Examiner rejects Claims 10, 11, and 15-17 under 35 U.S.C. 103(a), as being obvious over West (U.S. Patent No. 4,452,390) in view of GB 2039599 (GB '599).

The position of the Examiner can be found on pages 2-3 of the Office Action.

Applicant respectfully traverses.

Applicant reviewed the West reference and notes that compared with Claim 10, the reference fails to teach locking boreholes for locking and for receiving locking bolts associated with the case.

Applicant also notes that in the present invention, the case is provided with locking boreholes for receiving locking bolts that are provided in the case. Thus, the case can be introduced and locked to the housing providing a double security system, one system for locking of the case itself, and one system for locking into the housing.

In addition, Applicant notes that the GB'99 reference discloses a security box comprising a housing, a drawer having a lock in combination with locking pins 17. The locking pins are part of the independent lock system and not associated with the case.

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Further, Applicant notes that the combination of the lock and locking pin of the GB'99 reference is equal to the security locking system 28 of the present invention. Thus, the GB'99 reference also fails to teach the locking boreholes for locking and for receiving locking bolts associated with the case in addition to the independent locking system.

Combining the references

The Examiner is of the opinion that it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the locking boreholes of the housing of GB'99 and the locking bolts of the case of GB'99 in the housing and in the case of West, to secure the case in the housing.

Applicant does not agree with the Examiner's opinion. Applicant notes that the West reference requires the container to be closely fitted within jacket 11. The case is attached to the jacket only by close fit (Column 2, lines 5-16 and 37-39).

Lines 37-39 indicted:

"In order to permit safe or container 14 to be closely fitted within jacket 11, lock 28 must not protrude,"

Thus, if the inventor of the West reference admits that the lock CANNOT protrude from the case, how can the Examiner believe that there is a possibility of modifying the West reference by adding the borehole for locking and for receiving locking bolts

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(protruding from case) associated with the case of the GB reference?

A §103 rejection based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, is not proper and the *prima facie* case of obviousness cannot be properly made. In short, there would be no technological motivation for engaging in the modification or change. To the contrary, there would be a disincentive. In re Gordon 221 USPQ 1125 (Fed. Cir 1984).

Adding the boreholes of the GB reference to the West reference will prevent the container to be closely fit with the jacket, thus the function of the invention will be destroyed.

In addition, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combining in the manner claimed.

Using an applicant's disclosure as a blueprint to reconstruct the claimed invention from isolated pieces of the prior art contravenes the statutory mandate of § 103 which requires judging obviousness at the point in time when the invention was made.

Applicant reviewed the West and GB '599 references and notes that neither of the references show a case-safe system according

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to the present invention. The present invention is directed to a case that can be secured in a housing. The housing, as found in hotels, vehicles, etc, allows securing the case when traveling.

The West reference discloses a portable safe or security container that is designated for gambling establishments. Emphasis is put on improvement with respect to a currency-receiving slot preventing unauthorized removal of the content (so call drop box). Although this box is portable, it is not suited for traveling purposes.

The UK'599 reference is directed to a drawer, which is inserted into means for holding the same up against the underside of a supporting surface, like a desk. This drawer is in no way suited for traveling purposes since it is not closed nor is it provided with a handle.

Neither of the references taken along or in combination teaches the present invention as claimed.

Accordingly, withdrawal of the rejection is respectfully requested.

Regarding Claim 15

Applicant notes that the Examiner is wrong in his indication that reference number 12 of the West patent is a concealment covering. Applicant notes that reference 12 is directed to a counter top wherein the safe is attached. (Column 2, lines 1-5).

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Neither the West nor the GB references teach a safe having a concealment covering. Thus, Claim 15 is novel.

Accordingly, withdrawal of the rejection is respectfully requested.

The Examiner rejects Claim 12 under 35 U.S.C. 103(a) as being obvious over West in view of GB '599 as applied to claim 10 above, and further in view of Johnson et al. (U.S. Patent No. 2,819,692).

Applicant respectfully traverses for the same reasons as set forth in the previous paragraphs and the following remarks:

Claim 12 is novel in view of its dependency with novel Claim 10.

Accordingly, withdrawal of the rejection is respectfully requested.

The Examiner rejects Claim 18 under 35 U.S.C. 103(a) as being obvious over West in view of GB '599 as applied to Claim 15 above, and further in view of Cantlez (U.S. Patent No. 3,970,010).

Applicant respectfully traverses for the same reasons as set forth in the previous paragraphs and the following remarks:

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Claim 18 is novel in view of its dependency with novel Claim 10.

Accordingly, withdrawal of the rejection is respectfully requested.


Paragraph 8 (Allowable Subject Matter)

The Examiner indicates that Claims 13 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant is pleased with the Examiner's indication that Claims 13-14 contain allowable subject matter. Claim 13 has been re-written in independent form.

Favorable consideration and early issuance of the Notice of Allowance are respectfully requested. Should further issues remain prior to allowance, the Examiner is respectfully requested to contact the undersigned at the indicated telephone number.

Respectfully submitted,



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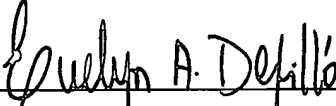
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CERTIFICATE OF MAILING AND AUTHORIZATION TO CHARGE

I hereby certify that the foregoing AMENDMENT B for U.S. Application No. 09/830,732 filed August 17, 2001, was deposited in first class U.S. mail, postage prepaid, addressed: Attn: Commissioner of Patents and Trademarks, P.O. Box 1450, Alexandria VA 22313-1450, on **September 26, 2003**.

The Commissioner is hereby authorized to charge any additional fees, which may be required at any time during the prosecution of this application without specific authorization, or credit any overpayment, to Deposit Account No. 16-0877.



Evelyn A. DeFillio